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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/505,052	02/16/2000	Donald R. Russell	P96005US2B	6415

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EXAMINER

HORTON, YVONNE MICHELE

ART UNIT	PAPER NUMBER
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3635

DATE MAILED: 12/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/505,052

Applicant(s)
DONALD R. RUSSELL ET AL.

Examiner
YVONNE M. HORTON

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Sep 10, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-8, 10-19, 21-24, and 27-33 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-8, 10-19, 21-24, and 27-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 13 recites the limitation "said step of removing" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 8,9,14,15 and 27-30 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 6,491,471 to SUSINSKAS. In reference to claims 8 and 27, the structure of SUSINSKAS inherently details a method for applying a walkway pad (1) to a rooftop, column 3, line 56, including the steps of providing a walkway pad (1) where the pad 91) includes an adhesive (11); applying the walkway pad (1) to a rooftop (unlabeled) by placing an exposed surface of the adhesive (11) to an upper surface of the rooftop. Regarding claim 9, the adhesive (11) is disposed about the back surface "proximal" the edges of the pad (1). In reference to claims 14 and 15, the adhesive (11) of the walkway pad (1) of SUSINSKAS is applied to the pad (1) at the place of manufacture and without priming. Regarding claims 28-30, SUSINSKAS

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discloses the use of a square pad (1) at least 60 inches square which is encompassed by the required 30 inches square; and a thickness of traditional EPDM that is 0.045-0.6 inches thick which is encompassed by the required 0.25-0.5 inches or preferably 0.30 inches.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 10-13,24 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #6,491,471 to SUSINSKAS in view of US Patent #3,937,640 to TAJIMA et al.

As noted in paragraph #2 above, SUSINSKAS discloses the basic claimed method except for the walkway pad explicitly being rubber based and except for the step of removing a release paper.

Regarding claims 10-12 and the fact that SUSINSKAS does not explicitly detail that his EPDM is rubber based, it is commonly known in the art that EPDM is a rubber based material.

However, TAJIMA et al. specifically details that his EPDM is rubber based, column 3, lines 50-60. In reference to claim 13, SUSINSKAS is silent with regard to preparing the roof prior to the step of removing, the roof area of TAJIMA et al. is prepared prior to removal of the release paper, column 11, line 64. Hence, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the EPDM of SUSINSKAS be rubber based, as taught by TAJIMA et al., and to prepare the roof surface of SUSINSKAS, also taught by TAJIMA et al. in order to ensure that the walkway pad adheres to the roof surface properly and without any obstructions. Regarding claim 24, SUSINSKAS does not detail the use of a release paper. TAJIMA et al. discloses the use of a release paper (14). Hence, it would have

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been obvious to one having ordinary skill in the art at the time the invention was made to provide the walkway pad of SUSINSKAS with the release paper of TAJIMA et al. in order to protect the adhesive while not in use and prior to walkway pad prior to assembly. In reference to claim 31, again SUSINSKAS is silent as to whether his walkway pad is textured or not, but TAJIMA et al. teaches that it is known in the art to texture (32,33) a roofing pad. Hence, it too would have been obvious to one having ordinary skill in the art to provide the walkway pad of SUSINSKAS with a textured surface as taught by TAJIMA et al. in order to give the walkway pad a pleasant appearance.

8. Claims 1-4,6-7,32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #6,491,471 to SUSINSKAS in view of US Patent #3,937,640 to TAJIMA et al.

Regarding claim 1, SUSINSKAS inherently discloses a method for applying a walkway pad (1) to a roofing membrane (not labeled) including the steps of providing a walkway pad (1); applying an adhesive (11) to a planar surface of the pad (1); and applying the walkway pad (1) to a rooftop (unlabeled) by placing an exposed surface of the adhesive (11) to an upper surface of the rooftop.

SUSINSKAS discloses the basic claimed method except for the steps removing a release paper and applying a force. In reference to the use of a release paper, TAJIMA et al. teaches that it is known in the art to provide a roofing pad with a release paper (14). Hence, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the walkway pad of SUSINSKAS with the release paper of TAJIMA et al. in order to protect the adhesive while not in use and prior to walkway pad prior to assembly. Although both SUSINSKAS and TAJIMA et al. are silent in regards to applying pressure, it would have been

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obvious to one having ordinary skill in the art at the time the invention was made that a force be applied to the walkway (1) in order to increase the surface adhesion and ensure attachment between the pads (1) and the roofing membrane (not labeled). In reference to claim 2-4,32 and 33, the walkway pads (1) of SUSINSKAS are EPDM which are inherently are rubber-based.

However, TAJIMA et al. specifically details that his EPDM is rubber based, column 3, lines 50-60. Hence, it would have been obvious to one having ordinary skill in the art the that EPDM of SUSINSKAS is rubber based EPDM, as taught by TAJIMA et al. Regarding claims 6 and 7, SUSINSKAS is silent with regard to the roof being prepared prior to removal of a release paper. However, TAJIMA et al. teaches that the roof area is prepared prior to removal of the release paper, column 11, line 64. Thus, it too would have been obvious to one having ordinary skill in the art at the time the invention was made to prepare the roof top prior to removing the release paper in order to ensure that the adhesive bond with the roof top without any obstructions.

9. Claims 16-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #6,491,471 to SUSINSKAS in view of US Patent #3,937,640 to TAJIMA et al. Regarding claim 16, SUSINSKAS discloses a method for applying a walkway pad (1) to a roofing membrane (not labeled) including the steps of preparing a walkway pad (1). SUSINSKAS discloses the basic claimed method except for the steps of carrying a release paper, bundling the walkway pads, and delivering the walkway pads. In reference to the use of a release paper, TAJIMA et al. teaches that it is known in the art to provide a roofing pad with a release paper (14). Hence, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the walkway pad of SUSINSKAS with the release paper of TAJIMA et al. in order to

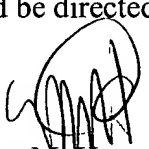
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protect the adhesive while not in use and prior to walkway pad prior to assembly. In reference to bundling, TAJIMA et al. teaches that it is known in the art to bundle the roof pads, column 1, lines 60-61. Although both SUSINSKAS and TAJIMA et al. are silent in regards to delivering the walkway pads, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the walkway pads of SUSINSKAS as modified by TAJIMA et al. be delivered to the proper personnel for application thereof. In reference to claims 17-19, the walkway pads of SUSINSKAS are EPDM pads which are inherently known as being rubber based. However, TAJIMA et al. teaches that it is known in the art to form a roofing pad from a rubber-based EPDM pad, column 3, lines 50-60. Regarding claim 20, the adhesive (11) of SUSINSKAS is disposed about the back surface "proximal" the edges of the pad (1). In reference to claim 21, the adhesive (11) is applied at the place of manufacture. Regarding claim 22, the pad (11) is applied also without priming.

Response to Arguments

10. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yvonne M. Horton whose telephone number is (703) 308-1909.



Yvonne M. Horton
Primary Examiner
December 1, 2003